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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,455	02/26/2004	Kevin Morrison	020375-043010	5172
20350	7590	10/18/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/789,455	MORRISON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	EDWYN LABAZE	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 February 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ .   | 6) <input type="checkbox"/> Other: _____ .                                  |

### **DETAILED ACTION**

1. Claims 1-27 are presented for examination.
2. This application claims the benefit of application No. 60/520,432 filed on 11/14/2003.

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-7, 10, 12-14, 17-18, 21-22, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lockwood (U.S. 5,576,951).

Re claims 1, 10, 13, and 21: Lockwood discloses automated sales and services system, which includes means of receiving at a host computer system a request from a purchaser to order the plurality of presentation instruments (col.6, lines 65-67; col.7, lines 1+); sending one or more files [such as case file 111] that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed [through the video screen 118 as disclosed col.13, lines 65+; col.16, lines 1-35] to collect purchase information relating to the plurality of presentation instruments (col.12, lines 48+); receiving at the host computer system the purchase information from the purchaser, wherein the purchase information comprises a recipient information file; and delivering the presentation instruments in accordance with the purchase information (col.7, lines 40-67; col.18, lines 56-67; col.19, lines 1+).

Re claims 3-5: Lockwood teaches a system and method, wherein delivering the presentation instruments in accordance with the purchase information comprises delivering the presentation instruments to each of a plurality of recipients, or to the purchaser or a designee of the purchaser (col.10, lines 1+; col.14, lines 10+; col.21, lines 60+).

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Re claims 6, 12, 14, and 24: Lockwood discloses a system and method, receiving at the host computer system a request from a user to view usage information relating to a presentation instrument; and sending a file to a computer of the user, wherein the file comprises the usage information (col.7, lines 15+; col.17, lines 15+; col.18, lines 56+).

Re claims 7, 18, and 25: Lockwood teaches a system and method, wherein the recipient information file comprises a selection from the group consisting of a spreadsheet, a text file 109, and a data file 266 (col.12, lines 61+; col.13, lines 4-30; col.22, lines 43+).

Re claims 17, and 22: Lockwood discloses a system and method, wherein the purchase information comprises a recipient information file 257 (col.22, lines 5-22).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 8-9, 11, 15-16, 19-20, 23, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood (U.S. 5,576,951) in view of Laurash et al. (U.S. 6,802,538).

The teachings of Lockwood have been discussed above. Lockwood further discloses that the system may be used in a variety of other service-oriented industries, such as retail sales and real estate, various financial services and the like (col.8, lines 40+); also a credit check and loan processing systems [through a financial institution 101] (col.12, lines 38+).

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Lockwood fails to teach that the presentation instruments comprises a selection from the group consisting of credit cards, gift cards, smart cards, stored value cards, and debit cards; means of personalizing [with the option of non-personalization] each card with an embossed message/name.

Lauraush et al. discloses gift card form and method of fabrication, which includes means of means of personalizing each card with an embossed message/name/greeting (col.4, lines 43-67).

In view of Laurash et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Lockwood means of personalizing [with the option of non-personalization] each card with an embossed message/name. Furthermore, such modification would extent the customer's option to order either one from the group consisting of credit cards, gift cards, smart cards, stored value cards, and debit cards with means of personalizing said card. Since Lockwood's system is designed to perform credit check and loan processing systems, therefore it would have been obvious to substitute into the operating software a subroutine permitting/allowing a customer means to order a credit card, gift card, smart card, stored value card, and debit card with personalization means. Moreover, such modification would have been an obvious extension as taught by Lockwood, therefore an obvious expedient.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Lockwood (U.S. 6,289,319) discloses automatic business and financial transaction processing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el

Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
October 12, 2004



KARL D. FRECH  
PRIMARY EXAMINER